

Appl. No. 10/779,980
Amdt. Dated March 27, 2006
Reply to Office Action dated December 27, 2005

REMARKS

Applicants acknowledge receipt of the Office Action dated December 27, 2005, in which the Examiner (1) entered a restriction requirement; (2) rejected claims 28-39 under 35 U.S.C. § 112, second paragraph, as being indefinite; (3) rejected claims 28-35 and 37-39 under 35 U.S.C. § 102(b) as being anticipated by Coates et al. (U.S. Patent 5,423,826) (hereinafter *Coates*); (4) rejected claims 28 and 31-32 under 35 U.S.C. § 102(b) as being anticipated by Judet (U.S. Patent 4,263,904) (hereinafter *Judet*); and (5) rejected claims 35 and 36 under 35 U.S.C. § 103(a) as being unpatentable over *Judet* in view of Rouse (U.S. Patent 2,002,021) (hereinafter *Rouse*).

Applicants affirm the election of Group III (claims 28-39) and have withdrawn claims 1-27.

Rejections under 35 U.S.C. § 112

The Examiner rejected claims 28-39 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 28 is an independent claim from which claims 29-39 depend.

Claim 28 has been amended to more particularly point out and distinctly claim the subject matter which applicant regards as the invention. No new matter is introduced by the amendment. Applicants believe the amendment should satisfy the Examiner's concerns regarding this issue. Claims 29-39 depend from claim 28. Since claim 28 is submitted to be definite, claims 28-39 are also definite.

Rejection for Anticipation by *Coates* under 35 U.S.C. §102(b)

The Examiner rejected claims 28-35 and 37-39 under 35 U.S.C. § 102(b) as anticipated by *Coates*. Applicants respectfully traverse the Examiner's rejections of these claims. Applicants respectfully submit that claims 28-35 and 37-39 as amended are not anticipated by *Coates* because *Coates* fails to disclose each and every limitation of these rejected claims.

In order to establish a *prima facie* case of anticipation, the Examiner must show that each and every element of the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). If a single element is not found in the prior art reference, the claims are not anticipated. Thus, an invention is anticipated only when the *same*

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device having all the elements contained in the claim limitations, is described in a single prior art reference.

Claim 28 as amended recites "the base adapted to releasably engage the plate between the at least two arms." Thus, the tensioner comprises at least two arms adapted to be releasably secured to the plate, **and** a shaft having a second end connected to the base, which is adapted to releasably engage the plate between the at least two arms. During use of the tensioner, the base engages plate 150 between the arms to facilitate the movement of the plate from the preformed shape to each of the at least one elastic shapes. Page 16, Lines 21-30; Figures 11 and 17. Amended Claim 28 recites a tensioner that is adapted to engage the plate in at least three locations. Nothing in *Coates* teaches or discloses a base adapted to releasably engage the plate between at least two arms.

Coates discloses a system for anterior fixation of the spine including a spinal fixation plate 20 and a holder-drill guide 150 for holding the spinal plate and drilling and tapping the bone. Col. 4, Lines 6-15; Figures 14 and 17. The *Coates* holder-drill guide 150 comprises two feet 157, two arms 151, 152 that pivot with respect to each other, a locking mechanism 153 and handle 162. Col. 4, Lines 6-13; Col. 13, Lines 4-15; Figure 17. The two feet 157 are attached to the ends of the arms 151, 152 and are adapted to securely grasp each end of plate 20. Col. 4, Lines 6-13; Col. 13, Lines 4-15; Figure 17. The locking mechanism 153 is tightened to attach the guide 150 to the plate 20. Col. 13, Lines 10-12; Figure 17. While guide 150 of *Coates* has two arms 151, 152 each having a foot 157 that is attached to plate 20, however, no other component(s) of the guide 150 disclosed by *Coates* attach to or engage plate 20. Thus, *Coates* does not teach or disclose a base adapted to releasably engage the plate between at least two arms as presently claimed. Therefore, Applicants submit that claim 28 is not anticipated by *Coates* because *Coates* fails to disclose each and every limitation of the rejected claim. Further, because *Coates* does not teach or suggest that guide 150 could be used to alter the curvature of plate 20, it would not be obvious to modify the *Coates* devices so that it could engage the plate between the arms. For all of these reasons, claim 28 is allowable over the art of record.

Dependent claims 29-39 must *a fortiori* also be allowable, as they carry with them all the limitations of the independent claim from which they depend.

In addition, claim 28 recites "a tensioner for facilitating the movement of the plate from the pre-formed shape to the at least one elastic shape that substantially corresponds to at least one

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of the at least one bone radii of curvature.” *Coates* does not teach or disclose a tensioner for facilitating the movement of the plate from the pre-formed shape to the at least one elastic shape that substantially corresponds to at least one of the at least one bone radii of curvature. Instead, *Coates* teaches a guide apparatus 150 for holding a spinal plate to drill and tap the bone. Abstract; Col. 4, Lines 6-9. The locking mechanism 153 disclosed by *Coates* is tightened to firmly attach the guide 150 to the plate 20. Col. 13, Lines 10-12. Once the plate 20 is held by the guide 150, the guide 150 and plate 20 may be positioned so that the bone can be tapped and drilled in order to fix plate 20 to the bone. Col. 4, Lines 6-26. Thus, *Coates* fails to teach or disclose a tensioner for facilitating the movement of the plate from the pre-formed shape to the at least one elastic shape that substantially corresponds to at least one of the at least one bone radii of curvature. Therefore, Applicants submit that claim 28 is not anticipated by *Coates* because *Coates* fails to disclose each and every limitation of the rejected claim. Likewise, dependent claims 29-39 are allowable because they include all the limitations of the allowable claim 28.

Rejection for Anticipation by *Judet* under 35 U.S.C. §102(b)

The Examiner rejected claims 28, and 31-32 under 35 U.S.C. § 102(b) as anticipated by *Judet*. Applicants respectfully traverse the Examiner's rejections of these claims. Applicants respectfully submit that claims 28, and 31-32 as amended are not anticipated by *Judet* because *Judet* fails to disclose each and every limitation of those claims.

Claim 28 is an independent claim from which claims 28-35 and 37-39 depend. Claim 28 as amended requires that the base releasably engage the plate between the at least two arms. Thus, the tensioner comprises at least two arms adapted to be releasably secured to the plate, and a shaft having a second end connected to the base, which is adapted to releasably engage the plate between the arms. Nothing in *Judet* teaches or discloses a base adapted to releasably engage the plate between the at least two arms.

Judet discloses an osteosynthesis device for holding together the parts of a fractured bone. Abstract; Col. 1, Lines 6-10; Figures 1-5. The device comprises a circular bracelet 1 having support points in the form of bosses 3, 4, and 5 or bosses 13 that contact the bone. Col. 1, Line 64 to Col. 2, Figures 1 and 9. Bracelet 1 may be spread open and placed around a bone by a spreading clarnp with two branches, each having a protrusion 14 that engages the wings 6 and 7 of bracelet 1.

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Col. 2, Line 66 to Col. 3, Line 3; Figures 11 and 12. In *Judet*, one protrusions 14 of the spreading claim engages a perforated wing 6 at one end of bracelet 1 and a second protrusion 14 of the spreading clamp engages a perforated wing 7 at the other end of bracelet 1. Figures 11 and 12. However, no other component(s) of the spreading clamp disclosed by *Judet* attaches to or engages bracelet 1. Thus, *Judet* does not teach or disclose a base adapted to releasably engage the plate between the at least two arms. Therefore, Applicants submit that claim 28 is not anticipated by *Judet* because *Judet* fails to disclose each and every limitation of the rejected claim. Because of the way that the spreading claim of *Judet* engages the bracelet, not only would it not be obvious modify the clamp so that it could contact the center of the bracelet, but there is no component of the spreading claim that could contact the bracelet between the arms. Again, dependent claims 29-39 must *a fortiori* also be allowable, as they depend from an allowable base claim.

In addition, claim 28 recites a shaft having "at least one screw groove disposed along the shaft longitudinal axis to facilitate the movement of the at least two arms along the longitudinal axis of the shaft." *Judet* does not teach or disclose at least one screw groove disposed along the shaft longitudinal axis. The Examiner states that *Judet* discloses "a tensioner (Figure 12) with shaft and base and at least two arms where any one of the holes along the shaft or arms are at least one screw groove." Although it is unclear what component(s) of *Judet* the Examiner believes equivalent to a shaft and a base, nothing in *Judet* teaches or discloses any screw groove anywhere in bracelet 1 or anywhere in the spreading claim. Thus, *Judet* does not teach or disclose at least one screw groove disposed along the shaft longitudinal axis. Therefore, Applicants submit that claim 28 is not anticipated by *Judet* because *Judet* fails to disclose each and every limitation of the rejected claim. Dependent claims 29-39 must *a fortiori* also be allowable, since they carry with them all the limitations of the independent claim to which they ultimately refer.

Rejection for Obviousness under 35 U.S.C. § 103(a)

The Examiner rejected claims 35 and 36 under 35 U.S.C. § 103(a) as being unpatentable over *Judet* in view of *Rouse*. Applicants respectfully traverse the Examiner's rejections of claims 35 and 36 as being unpatentable over *Judet* in view of *Rouse*.

In order to establish a *prima facie* case of obviousness, the Examiner must meet the following three elements: 1) there must be some suggestion or motivation, either in the references

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themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *MPEP* § 2143 (2000) (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Applicants submit that the Examiner has failed to make a *prima facie* case of obviousness in rejecting claims 1-14.

One element required to establish a *prima facie* case of obviousness is that the prior art references must teach or suggest all the claim limitations. Claim 1 has been amended to more distinctly claim a "base adapted to releasably engage the plate between the at least two arms." Claims 35 and 36 depend from independent claim 28. In rejecting claims 35 and 36, the Examiner relies on *Judet* to teach all the limitations of base claim 28. However, as previously discussed, *Judet* does not teach or disclose a base adapted to releasably engage the plate between the at least two arms. These limitations missing from *Judet* cannot be supplied by *Rouse*. Applicants therefore respectfully submit that the Examiner has failed to demonstrate a *prima facie* case of obviousness in rejecting claims 35 and 36, because the Examiner has failed to cite references that teach or suggest all of the elements recited in the rejected claims. Since independent claim 28 is submitted to be allowable, dependent claims 35 and 36 must *a fortiori* also be allowable, since they carry with them all the limitations of such independent claims.

Conclusion

Applicants believe that the present amendments place all of the claims in condition for allowance. Entry of the amendments and allowance of the case is therefore respectfully requested. If the Examiner has any questions or comments, or otherwise feels it would be advantageous, he is encouraged to telephone the undersigned at (713) 238-8000.

Respectfully submitted,



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